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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,120	06/16/2006	Carine Boursier	1032326-000400	1809

21839 7590 09/14/2010  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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OBAYANJU, OMONIYI

ART UNIT	PAPER NUMBER
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2617

NOTIFICATION DATE	DELIVERY MODE
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09/14/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/583,120	<b>Applicant(s)</b> BOURSIER ET AL.	
	<b>Examiner</b> OMONIYI A. OBAYANJU	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/29/2010 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 07/29/2010 have been fully considered but they are not persuasive.

**In regards to the amended independent claims, Applicant amended and argued** that the prior art references (Simmons and Portalier) failed to teach or disclose at least in part ***“elements having the functionality of the claimed “storage support module” and “secure electronic module.” For example, the references say nothing with regard to, at least, “establish[ing] ... in the event the secure electronic module determines that the storage support module is authentic, a secure communication channel,” “encrypt[ing], by the storage support module, the IMEI using [a] first key,” “decrypt, by the secure electronic device, the***

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***encrypted IMEI received from the storage support module using [a] second key" and "enabl[ing], by the secure electronic module, the handset to access the communication network in the event the secure electronic module determines that the decrypted IMEI received from the storage support module is authentic," as recited in claim 18".***

**In response the Examiner respectfully disagrees with Applicant's argument.** First, the Applicant amended the claimed limitations of at least the independent claims to include various terms and/or limitations which are not clearly defined or described and/or mentioned in the original specification on record. For example, Applicant specifically stated two different and/or separate keys i.e. ("first and second keys") for the process of "encrypting and decrypting" as stated in the amended claimed limitations above. Although, the Applicant's original specification on file, **pg. 7, lines 5-12**, recites;

"In order to secure the channel 6 and to perform any necessary authentications between the storage support 2 and the module 31, **the support 2 and/or the module can store encryption keys adapted to the desired type of encryption or authentication.** The types of encryption or authentication to be used are already known. It is possible, in particular, to consider using session keys or static keys".

At least in light of the of the recitation above, and the Applicant's specification as a whole, there was nothing mentioned and/or described to support the newly added or amended limitations i.e. at least in part **"decrypt, by the secure electronic device, the encrypted IMEI received from the storage support module using the second key"**.

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Therefore, the specific process of decrypting by a second key, and encrypting by a first key as stated in the amended claimed limitations were never mentioned and/or inconsistent with Applicant's specification. Therefore, the introduction of new terms and/or limitations that are not supported and/or clearly described by the specification raises the issue of new matter.

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 18-20**, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

At least in light of the Applicant's specification as a whole, there was nothing mentioned and/or described to support the newly added or amended limitations i.e. at least in part **“decrypt, by the secure electronic device, the encrypted IMEI received from the storage support module using the second key”**. Therefore, the Applicant described two different and/or separate specific process of decrypting by a second key,

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and encrypting by a first key as stated in the amended claimed limitations which were never mentioned and/or inconsistent with Applicant's specification. Therefore, the introduction of new terms and/or limitations that are not supported and/or clearly described by the specification raises the issue of new matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-7, 9, 11-16, and, 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892).

As to claims 18, 19, 20, 5, and 12, Simmons teaches a telephone handset, comprising (fig. 1, #10): a storage support module storing an International Mobile Equipment Identity (IMEI) associated with an operator of a communication network and a first key (pg. 2, pp 0026, lines 1-4, and pp0039); a secure electronic module storing a second key (SIM, pg. 1, pp0006, fig. 3, and pp0051); a processor (fig. 1, Microcontroller); a memory device including program instructions that, when executed by the processor, control the handset to: authenticate, by the secure electronic module, the storage support module (pg. 3, pp 0030); establish, in the event the secure

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electronic module determines that the storage support module is authentic, a communication channel between the storage support module and the secure electronic module (pg.3, pp0042, pp0049); encrypt (authenticate) by the storage support module, the IMEI using the first key (pg. 3, pp0039, and fig. 3); transmit, via a communication channel, the encrypted (authenticated) IMEI from the storage support module to the secure electronic module (pg. 4, pp 0049 lines 9-12, and fig. 3); decrypt (verify), by the secure electronic device, the encrypted (authenticated) IMEI received from the storage support module using the second key (pg. 3, pp0042, pp0039, and pp0018); enable, by the secure electronic module, the handset to access the communication network in the event the secure electronic module determines that the decrypted (verified) IMEI received from the storage support module is authentic (pg. 3, pp0028, pp0042, pp0039, and pp0018, fig.1, and fig. 3). However, Simmons fails to explicitly teach an encrypted communication channel between the first data storage device and the second data storage device, and access, by the handset, the communication network using the authenticated IMEI, wherein the network grants access to the handset without further authentication of the authenticated IMEI.

But, Portalier teaches an encrypted communication channel between the first data storage device and the second data storage device (pg. 3, lines 21-26) and access, by the handset, the communication network using the authenticated IMEI, wherein the network grants access (permit use of mobile telephone) to the handset without further authentication of the authenticated IMEI (pg. 7, lines 20 - pg. 8, lines 13). Thus, it would have been obvious to one of ordinary skill in the art at time the invention

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was made to modify the terminal equipment teachings of Simmons with the teachings of Portalier to achieve an efficient, reliable, and secure communication link between devices in communication system.

As **to claims 2 and 9**, Simmons teaches wherein the operating system (fig. 1, Microcontroller) controls the transmission of the IMEI to a mobile telephone operator by means of a secure OTA channel (pg. 3, pp 0038, lines 4-8).

As **to claim 4**, Simmons teaches wherein the secure electronic module is a UICC (SIM card) (pg. 3, pp 0028).

As **to claim 6**, Simmons teaches wherein the secure electronic module and the storage support module store encryption keys that are used to encrypt the secure communication channel (pg. 3, pp 0041, lines 1-10, and pp0042).

As **to claims 7, 11, and 13-16**, Simmons teaches wherein the secure electronic module device blocks the use of the handset when a false IMEI is detected (pg. 3, pp 0038 lines 4-7, and pp 0040).

Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892) as applied to claim 9 above, and further in view of Applicant's Admitted Prior Art (AAPA).

As **to claims 10 and 17**, Simmons and Portalier teaches the limitations of claim 9 as discussed above. However, they fail to teach the operator comparing the IMEI with



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a black list of stolen handsets. Applicants Admitted Prior Art (AAPA) as set forth in Paragraph [0003] of the specification background teaches these limitations of claims 10 and 17 (blocking). Thus, it would have been obvious to one of ordinary skill in the art at time the invention was made to include the teachings the Applicants Admitted Prior Art in the securing method of Simmons and Portalier in order to achieve the goal of efficiently securing a mobile terminal from an unauthorized use.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMONIYI A. OBAYANJU whose telephone number is (571)270-5885. The examiner can normally be reached on Mon - Fri, 7:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on 571-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O. A. O./  
Examiner, Art Unit 2617

/VINCENT P. HARPER/  
Supervisory Patent Examiner, Art  
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